

REMARKS

The Examiner proclaims that "... the USPTO has the authority to ignore the law ..." and maintains the current Restriction Requirement. *Office Action pg. 2*. The Applicants thereby reserve the right to petition this decision. Further, the Examiner has stated several issues regarding the presently claimed embodiment and the Applicants list them below in the order that they are addressed.

- I. Claims 1, 11 and 21 are objected to.
- II. Claims 21 and 26 are rejected under 35 U.S.C. § 112 ¶ 2 as allegedly being indefinite.
- III. Claims 21-24 and 26-29 are rejected under 35 U.S.C. § 112 ¶ 1 as allegedly failing to comply with the written description requirement.

I. The Claims Are Not Objectionable

The Examiner states that "Claims 1, 11 and 21 contain language drawn to non-elected sequences". *Office Action pg. 2*. The Applicants disagree and incorporate by reference the arguments made in the previous office action response. Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claims 1 & 21 by deleting SEQ ID NO:49. Further, Claim 11 has been amended by deleting SEQ ID NO: 50. These amendments are made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Examiner is respectfully requested to withdraw the present rejection.

III. The Claims Comply With 35 U.S.C. § 112 ¶ 2

The Examiner states that the phrase "capable of synthesizing" in Claims 21 and 26 "is unclear in that it is unclear under what conditions would the Claimed element be "capable of synthesizing". *Office Action pg 3*. The Applicants disagree and argue that the Applicants' specification provides a full and complete description of the synthesis conditions. The Examiner is reminded that claims are to be interpreted 'in light of the

specification'.¹ Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claims 21 and 26 to recite "which synthesizes" as kindly suggested by the Examiner. The Applicants do not believe that this amendment changes either claim scope or interpretation. These amendments are made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Applicants, therefore, respectfully request the Examiner to withdraw the present rejection.

IV. The Claims Comply With 35 U.S.C. § 112 ¶ 1

The Examiner states that Claims 21-24, 26-29 are rejected as allegedly failing to comply with the written description requirement because "... the Applicant does not disclose a representative number of species as encompassed by these claims ...". *Office Action*, pg 5. The Applicants disagree because a proper interpretation of Federal Circuit written description requirements present the alternative between "a representative number of species" OR having "common structural features". *Regents of the University of California v. Eli Lilly and Co.*, 119 F.3d 1559, 1569 (Fed. Cir. 1997). Nevertheless, the Applicants submit that this rejection is moot based upon the above claim amendments discussed in Section I.

The Applicants, therefore, respectfully request the Examiner to withdraw the present rejection.

¹ *Application of Salem*, 553 F.2d 676, 683, 193 USPQ 513 (CCPA 1977)

CONCLUSION

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and objection. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

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